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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,663	07/20/2007	Dusan Miljkovic	100700.0033US	2456
24392 7590 06/12/2009 FISH & ASSOCIATES, PC ROBERT D. FISH 2603 Main Street Suite 1000 Irvine, CA 92614-6232				
EXAMINER				
FLOOD, MICHELE C				
ART UNIT		PAPER NUMBER		
1655				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,663

Applicant(s)

MILJKOVIC, DUSAN

Examiner

Michele Flood

Art Unit

1655

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 11, 2009 has been entered.

Claims 1, 3-18 and 20 are under examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-18 and 20, as amended, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Newly applied as necessitated by amendment.

The metes and bounds of Claims 1 and 15 are rendered vague and indefinite by the phrase, "a sub-ripe, primarily red or almost red", because it is unclear as to whether the subject matter to which Applicant intends to seek patent protection is directed to a composition prepared from a 'sub-ripe, primarily red or an almost red' coffee cherry or a

composition prepared from a sub-ripe or a primarily red or an almost red' coffee cherry. The lack of clarity renders the claims vague and ambiguous.

Each of Claims 1 and 15 recites the limitation "wherein the *Coffea spec.* (coffee) used for the composition". There is a lack of clear antecedent basis for this limitation in the claims. Applicant may overcome the rejection by deleting the phrase, used for the composition prepared from whole *Coffea spec.* cherry, which appears in lines 2-3 of Claim 1, and lines 4-5 of Claim 15.

Regarding claim 5, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

Claim 7 recites the limitation, "further comprising an extract prepared from at least two of a bean of the *Coffea spec.* (coffee) cherry, a pulp of the *Coffea spec.* (coffee) cherry, a mucilage of the *Coffea spec.* (coffee) cherry, and a hull of the *Coffea spec.* (coffee) cherry", which renders the metes and bounds of the claimed invention vague and indefinite. For instance, the preamble of Claim 1, from which Claim 7 directly depends, recites "A cosmetic composition comprising a composition prepared from a whole *Coffea spec.* (coffee) cherry"; and, thus it is unclear as to what is the criticality for the requirement that the claimed composition is prepared from a 'whole *Coffea spec.* (coffee) cherry', if only two portions of the claim-designated plant material is required in the making of the claimed 'further' comprising an extract prepared therefrom. Thus, as presently drafted, the limitations of Claim 7 appear to negate the subject matter encompassing the scope of the preamble recited in Claim 1. The lack of clarity renders the claimed subject matter ambiguous and confusing, as the phrase may be interpreted

as reading on a composition prepared from a whole coffee cherry; and 'further comprising an extract prepared from at least two of the claim-designated plant materials recited in the Markush group of Claim 7.

Each of Claims 6 and 15 recites the limitation "the *Coffea spec.* (coffee) preparation" in lines 1-2. There is insufficient antecedent basis for this limitation in the claims.

The metes and bounds of Claims 8 and 9 are rendered uncertain because the percentage amounts of the ingredients are not set forth in terms of either "by weight" or "by volume" percentage amount of the total weight amount of the composition. The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

All other cited claims depend directly or indirectly from rejected claims and are, therefore, also, rejected under U.S.C. 112, second paragraph for the reasons set forth above.

Claim Objections

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. In the instant case, Claim 3 fails to further limit the subject matter of Claim 2 because Claim 2 is cancelled.

Claims 8, 10 and 11 are objected to because of the following informalities:

Claim 8 omits an ampersand between "trigonelline," and "wherein" in line 4. Applicant may overcome the objection by adding and between after the comma appearing after "trigonelline".

Claim 10 recites "coffee acids includes"; and, therefore there is no agreement between the noun and the verb recited in the claim language. Applicant may overcome the objection by replacing "includes" with include.

Claim 11 recites "monosaccharides includes"; and, therefore there is no agreement between the noun and the verb recited in the claim language. Applicant may overcome the objection by replacing "includes" with include.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4-7 and 12-14, as amended, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertrand et al. (U; Bertrand, C. et al. Plant Science, 2001; 165: 1355-1361. Chlorogenic acid content swap during fruit maturation in *Coffea pseudozanguebariae* qualitative comparison with leaves.) in view of Linter. (N; WO 9963963 A1). Newly applied as necessitated by amendment.

Applicant claims a cosmetic composition comprising a composition prepared from a whole *Coffea spec.* (coffee) cherry, wherein the whole *Coffea spec.* (coffee) cherry used for the composition prepared from whole *Coffea spec.* (coffee) cherry is a sub-ripe, non-primarily red or almost ripe dried *Coffea spec.* (coffee) cherry that has a mycotoxin level of less than 20 ppb (part-per-billion) for total aflatoxins, less than 10 ppb for total ochratoxins, and less than 5 ppm for total fumonisins. Applicant further claims the cosmetic composition of claim 1 wherein the composition prepared from whole *Coffea spec.* (coffee) cherry is a preparation from a quick-dried *Coffea spec.* (coffee) cherry. Applicant further claims the cosmetic composition of claim 4 wherein the *Coffea spec.* (coffee) cherry is quick-dried such that a mycotoxin level of the *Coffea spec.* (coffee) cherry is less than 20 ppb (part-per-billion) for total aflatoxins, less than 10 ppb for total7, and less than 5 ppm for total fumonisins. The cosmetic composition of claim 1 wherein the *Coffea spec.* (coffee) cherry preparation comprises at least one of an aqueous extract and an alcoholic extract; further comprising an extract prepared from at least two of a bean of the *Coffea spec.* (coffee) cherry, a pulp of the *Coffea spec.* (coffee) cherry, a mucilage of the *Coffea spec.* (coffee) cherry, and a hull of the *Coffea*

spec. (coffee) cherry; wherein the composition is formulated as one of a shampoo, a lotion, a cream, a balm, and an ointment; further comprising an information associated with the composition that the composition comprises the composition prepared from whole *Coffea spec.* (coffee) cherry; and, further comprising an information associated with the composition that the composition has an effect selected from the group consisting of an antioxidant effect, an anti-inflammatory effect, a UV (ultraviolet)-protective effect, an antimutagenic effect, a chemoprotective effect, a scar reducing effect, a skin-lightening effect, a moisturizing effect, a wrinkle reduction effect, and an antibacterial effect.

Betrand teaches extraction of chlorogenic acids from freeze-dried whole *Coffea spec.* (coffee) cherry with methanol-water. See page 1356, under "s. *Material and methods*" at 4 different stages of maturity. Given that Betrand teaches freeze drying the collected samples immediately after collection, it is deemed that the reference freeze-dried cherry is a quick-dried coffee cherry that has a mycotoxin level of less than 20 ppb (part-per-billion) for total aflatoxins, less than 10 ppb for total ochratoxins, and less than 5 ppm for total fumonisins, and that the cherry is a sub-ripe, primarily red or almost red dried coffee cherry.

The teachings of Betrand are set forth above. Betrand does not specifically teach a cosmetic composition. However, it would have been obvious to one of ordinary skill in the art to use the whole coffee cherry extract taught by Betrand to prepare the instantly claimed composition because at the time of the invention Lintner taught a cosmetic composition comprising chlorogenic acid from coffee extract and shea butter

extracts for soothing the skin and reducing inflammation, lines and wrinkles, by combating effects of free radicals and containing coffee and shea butter extracts. Lintner taught cosmetic and dermatological compositions in the form of emulsions, milks, lotions, gels, creams, sticks, crayons, sprays and shampoos comprising the chlorogenic acid. At the time the invention was made, one of ordinary skill in the art would have been motivated and one would have had a reasonable expectation of success to use the Bertrand' composition in the making of the claimed invention because Lintner taught that chlorogenic acid from coffee was useful in the making of cosmetic composition; and, Bertrand taught that the concentrations of chlorogenic acids increase during the maturation of a coffee cherry.

Accordingly, the claimed invention was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

Claims 15-18 and 20 rejected under 35 U.S.C. 103 (a) as being unpatentable over Bertrand ET al. (U; Bertrand, C. et al. Plant Science, 2001; 165: 1355-1361. Chlorogenic acid content swap during fruit maturation in *Coffea pseudozanguebariae* qualitative comparison with leaves.) and Linter. (N; WO 9963963 A1) in view of The Free Dictionary by Farlex. "Marketing". <http://financial-dictionary.thefreedictionary.com/marketing>. Downloaded December 8, 2007. Newly applied as necessitated by amendment.

Applicant claims a method of marketing a cosmetic composition comprising a step of providing the cosmetic composition and a further step of providing an information that the composition comprises a composition prepared from a whole *Coffea spec.* (coffee) cherry, wherein the whole *Coffea spec.* (coffee) cherry used for the composition prepared from the whole *Coffea spec.* (coffee) cherry is a sub-ripe, primarily red or almost ripe dried *Coffea spec.* (coffee) cherry that has a mycotoxin level of less than 20 ppb (part-per-billion) for total aflatoxins, less than 10 ppb for total ochratoxins, and less than 5 ppm for total fumonisins. Applicant further claims the method of claim 15 wherein the composition prepared from whole *Coffea spec.* (coffee) cherry comprises an extract of the *Coffea spec.* (coffee) cherry; and, the information is associated with the cosmetic composition. Applicant further claims the method of claim 17 wherein the information is printed on at least one of a container containing the cosmetic composition and a package containing the container. Applicant further claims the method of claim 15 wherein the composition prepared from whole *Coffea spec.* (coffee) cherry is a preparation from a quick-dried *Coffea spec.* (coffee) cherry.

The combined teachings of Bertrand and Lintner are set forth above. The combined teachings do not teach a method of marketing the instantly claimed composition. However, The Free Dictionary by Farlex the concept of marketing a product generally entails the following aspects:

"The activities of a company associated with buying and selling a product or service. It includes advertising, selling and delivering products to people. People who work in marketing departments of companies try to get the attention of target audiences by using slogans, packaging design, celebrity endorsements and general media exposure. The four 'Ps' of marketing are product,

place, price and promotion. Notes: Many people believe that marketing is just about advertising or sales. However, marketing is everything a company does to acquire customers and maintain a relationship with them. Even the small tasks like writing thank-you letters, playing golf with a prospective client, returning calls promptly and meeting with a past client for coffee can be thought of as marketing. The ultimate goal of marketing is to match a company's products and services to the people who need and want them, thereby ensure profitability".

Thus, given the teachings of the combined teachings as a whole, the instantly claimed method would have been *prima facie* obvious because a method of marketing a cosmetic composition wherein the information about the cosmetic product is printed on at least one of a container containing the formulation and a package containing the container would have been well within the purview of one ordinary skill in the art at the time the invention was made. One of ordinary skill in the art would have been motivated and one would have had a reasonable expectation of success to modify the teachings of the combined teachings of Betrand and Lintner to provide the instantly claimed method of marketing a cosmetic prepared from a whole *Coffea spec.* (coffee) cherry, wherein the whole *Coffea spec.* (coffee) cherry used for the composition prepared from the whole *Coffea spec.* (coffee) cherry is a sub-ripe, quick-dried *Coffea spec.* (coffee) cherry that has a mycotoxin level of less than 20 ppb (part-per-billion) for total aflatoxins, less than 10 ppb for total ochratoxins, and less than 5 ppb for total fumonisins because the combined teachings of Betrand and Lintner provide detailed information heralding the beneficial functional activities of the product upon application, as well as all of the ingredients and amounts of ingredients used in the making of the reference formulations. Therefore, the instantly claimed method would have been no

more than a matter of routine optimization to provide a result effect variable for the commercialization of the cosmetics taught by the combined teachings, especially since the information associated with such a composition would promote and emphasize the fact that it was low in mycotoxins; and, therefore non-toxic and fit for human use.

Furthermore, common sense would have dictated and rendered the claimed method of marketing *prima facie* obvious to one of ordinary skill in the art because at the time the invention was made it was old and conventional in the art of marketing a cosmetic, such as the skin and hair compositions taught by the combined teachings of Betrand and Lintner, that the placement of printing or printed material on a container detailing information about the cosmetic, as well as on the packaging the container, was beneficial in providing a vehicle for containing the product and a viable means for the mass distribution, delivery and storage of the product wherein the printed information on the container provides a means for the identification, promotion and sale of a product to a consumer base in want or need of a cosmetic product having beneficial functional effects.

Accordingly, the claimed invention was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is 571-272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michele Flood
Primary Examiner
Art Unit 1655

MCF
June 8, 2009

/Michele Flood/
Primary Examiner, Art Unit 1655